

Response filed December 28, 2011

Reply to OA dated September 29, 2011

REMARKS

Claims 1, 9, 10 and 18 are pending in this application. No amendment is made in this Response. It is believed that this Response is fully responsive to the Office Action dated **September 29, 2011**.

Claims 1, 9, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomioka (U.S. Pat. No. 5,079,030) in view of Takashi et al. (JP Pub. No. 2001-149857) and Carpenter (U.S. Pat. No. 5,320,673) and Noritake et al. (JP 2003-117481) and Yoshioka et al. (U.S. PGPUB No. 2002/0007769). (Office action paragraph no. 1, page 4)

The rejection of claims 1, 9, 10 and 18 is respectfully traversed, and reconsideration is requested.

[I] In the Amendment of June 28, 2011, Applicant amended the claims to restrict the substrate, and thereby clarify that the "substrate" does not comprise an aqueous luster thermosetting base coating film. Regarding this point, the Examiner, on page 2, second paragraph from the bottom, of the outstanding Office Action, merely contends as follows:

"Tomioka teaches the newly claimed 'substrate', as Tomioka teaches the substrate being an automobile body part (column 3, lines 15-16), where the body part has an undercoat, an intermediate coat, and a colored base coat (column 3, lines 43-57 and Figure 5, note that element 2 is an undercoat, element 3 is an intermediate coat, and element 4a is a colored base coat)."

The present invention is directed to a method comprising applying an aqueous luster thermosetting base coating composition (A) to a substrate in two to five stages, in such a manner that the thickness of the base coating composition (A) applied in each of the second and

subsequent stages becomes 0.3 to 5 μm when cured. Further, as stated above, the substrate does not comprise an aqueous luster thermosetting base coating film.

Accordingly, as Applicant argued in the Amendment dated June 28, 2011, the method of the present invention is different from that of Tomioka, wherein metallic paint is painted on a substrate in such a manner that the thickness of the metallic paint applied becomes 8 μm when cured. The present invention is thus not obvious over Tomioka.

[II] In response to Applicant's arguments regarding Declarations I and II on pages 10-12 of the last Amendment, and in particular, to the arguments regarding Declaration III at pages 12-15, the Examiner implies that the evidence provided is not commensurate in scope with the claims, stating (page 2, last paragraph, of the Office action):

"the claims still broadly recite any water-soluble or water-dispersible, crosslinkable functional group-containing resin, and any crosslinking agent and any flaky luster pigment having the recited dimensions. The Declarations can not be used to suggest that the parameters of the claims will provide similar unexpected results for any imaginable combination of resin, crosslinking and flaky luster pigment as is presently claimed."

However, Applicant respectfully submits that Declaration III was specifically provided in the last Amendment to address this issue. In Declaration III, two different aqueous luster thermosetting compositions (A-2) and (A-3) are used, both of which are compositionally different from the base coating compositions used in Declarations I and II.

Applicant's argument is that the critical limitations in the claims are the limitation on the **number of stages** of coating of the aqueous luster thermosetting base composition in step (1) and on the uncured or heat-cured coating layer of the base coating composition in step (3), and on the **thickness applied** in each of these stages. That is, these are the critical parameters, and the specific composition does not matter.

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The Examiner appears to request evidence for “any imaginable combination of resin, crosslinking and flaky luster pigment,” but this is, of course, impossible to provide, and Applicant submits that such a request is inappropriate. Applicant has adequately demonstrated that the critical limitation in the claims is the limitation on the **number of stages** of coating of the aqueous luster thermosetting base composition in step (1) and on the uncured or heat-cured coating layer of the base coating composition in step (3), and on the **thickness applied** in each of these stages. Applicant has demonstrated that these limitations are critical for a variety of different aqueous luster thermosetting compositions. The Examiner’s rejection appears to be based on the Examiner’s assumption that unspecified compositional limitations will somehow affect the demonstrated criticality, but Applicant submits that there is no basis for such an assumption.

Applicant therefore maintains that Applicant has adequately demonstrated unexpected results commensurate in scope with the claims.

Claims 1, 9, 10 and 18 are therefore not obvious over Tomioka (U.S. Pat. No. 5,079,030), Takashi et al. (JP Pub. No. 2001-149857), Carpenter (U.S. Pat. No. 5,320,673), Noritake et al. (JP 2003-117481) and Yoshioka et al. (U.S. PGPUB No. 2002/0007769), taken separately or in combination.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

U.S. Patent Application Serial No.: **10/576,193**

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In the event that this paper is not timely filed, the applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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